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Elsa Keller		RIDER, JUSTIN W		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/625,960	Applicant(s) RUETSCHI, JOHANNES	
	Examiner Justin W. Rider	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. In response to the Office Action mailed 23 February 2007, applicant submitted a response filed 23 May 2007, in which the applicant amended claims 2, 4, 18-19, 22, 24 and 38-39 without adding new matter.

Response to Remarks

2. Applicant's remarks filed 23 May 2007 have been fully considered but they are not persuasive. The examiner agrees with applicant's assertion that **Pizano** discloses at least one aspect of applicant's invention. This is believed to be an aspect that embodies the main scope of applicant's invention, namely the ability to provide annotations to messages retrieved by a user that are stored on a Universal or Unified Message server. While the examiner does concede that not every point disclosed by applicant is inherently taught by **Pizano**, it is asserted that the claimed limitations are, in fact disclosed within the teachings of **Pizano** within the same field of endeavor all while attempting to achieve the same results.

On page 9 of Remarks, applicant notes that within the system of **Pizano**, an annotation may be included in a reply however a **Pizano** reply is not an annotation (Remarks, p. 9). The examiner is interpreting this to intend that a reply message within applicant's scope of invention is the annotation itself. While the examiner does not necessarily agree or disagree with this statement, applicant is directed to the preamble of claim 1, wherein applicant claims, 'a method for inserting a caller's speech annotations into an original message.' [emphasis supplied] **Pizano** further discloses (Abstract), 'through a standard e-mail protocol used to add voice reply messages from a message generator,' [emphasis supplied]. Thus, **Pizano** provides wherein a

caller can retrieve messages from a universal server and subsequently add annotation messages (e.g. comments or notes) to said retrieved messages.

With respect to applicant's assertion that **Pizano** fails to disclose, 'annotating said speech message with at least one speech annotation; and inserting said speech annotation into said original message, once again the examiner points to the Abstract for this teaching of a message annotation system. **Pizano** discloses a, 'universal messaging server which provides a repository for voice, fax, e-mail, etc. This interface is accomplished through a standard e-mail protocol used to add voice reply messages...' [emphasis supplied]. This passage clearly discloses wherein input voice messages are remotely accessed and further annotated with voice reply messages by means of insertion.

Further, regarding applicant's notes in the present application, these opinions shared by applicant appear to differ from the examiner's reading of **Pizano's** disclosure. In the Abstract (as cited above) as well as on page 2, lines 17-22, **Pizano** discloses the retrieval of, as well as the annotation of text portions of e-mail messages stored on a universal messaging server.

Further, while it might be an accurate contention that **Pizano** fails to provide annotations in the form of user entered notes and comments this defining feature is simply not conveyed within the claims of applicant's application. The claim language calls for inserting user-defined voice messages, in which **Pizano** supplies in the form of messages 'pulled' from a message generator.

Claim Objections

3. Claims 2 and 22 are objected to because of the following informalities: Claim 2, line 2 references 'the step of providing said text email message.' However, there is no antecedent basis for this limitation. For examination purposes, the examiner will assume that applicant is referring to the limitation of claim 1, line 3, 'providing a speech rendering...' The same issue arises in the language of claim 22. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-8, 10-11, 13-15, 17-18, 20-28, 30-31, 33-35, 37-38, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by **Pizano et al. (EP o 865 189 A2)** referred to as **Pizano** hereinafter.

Claims 1 and 21: **Pizano** discloses a method and apparatus for inserting a user's [callers] annotations into a message, comprising:

- i. providing a speech rendering of said original message (Abstract);
- ii. annotating said speech message with at least one speech annotation (Abstract); and
- iii. inserting said speech annotation into said original message (Abstract).

Claims 2 and 22: **Pizano** discloses a method and apparatus as per claims 1 and 21 above wherein said original message is a text E-mail message (page 2, lines 15-20) provided by

accessing a Unified [Universal] Messaging server (Abstract) and retrieving said text email message (Abstract, p. 2, lines 17-22).

Claims 3 and 23: **Pizano** discloses a method and apparatus as per claims 1 and 21 above wherein said original message contains at least one attached document (page 2, lines 22-26, Fig. 16).

Claims 4 and 24: **Pizano** discloses a method and apparatus as per claims 1 and 21 above wherein original message is a voice message (page 2, lines 29-33) provided by accessing a Unified [Universal] Messaging server (Abstract) and retrieving said voice message (Abstract, p. 2, lines 17-22).

Claims 5 and 25: **Pizano** discloses a method and apparatus as per claims 2 and 22 above wherein said step of providing a speech rendering of said original message comprises converting said text message to speech (page 5, lines 25-26, 'given the option to receive an audible version of the message over the phone,').

Claims 6 and 26: **Pizano** discloses a method and apparatus as per claims 3 and 33 above wherein said step of providing a speech rendering of said original message comprises converting said attachment to speech (page 2, lines 34-36, 'controls a media converter which converts media to fax or *media to audio and an audio/fax player*, [emphasis supplied]).

Claims 7 and 27: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of connecting to the mailbox of said email message by establishing a voice connection using a landline telephone or a mobile telephone (page 3, lines 27-28; Fig. 2).

Claims 8 and 28: **Pizano** discloses a method and apparatus as per claims 1 and 21 above wherein said annotating step includes recognition of predefined commands for starting and

stopping said speech annotation (page 4, lines 27-28, 'Message generator 23 records voice from the user;' page 5, lines 35-55 discloses a sample of an interaction where a user controls the functions regarding review, start, stop, etc...). Therefore, it is inherent that if a user has the ability to record their voice and review/save recognized input using interaction with the system over the telephone, that one would be able to control the starting/stopping of messages (e.g. annotations or notes).

Claims 10 and 30: **Pizano** discloses a method and apparatus as per claims 8 and 28 above wherein said commands are entered via Dual Tone Multi-Frequency (DTMF) tones (page 5, lines 35-55).

Claims 11 and 31: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of using an interactive voice response (IVR) (page 5, lines 31-55 discloses wherein a prerecorded voice interactively responds to commands spoken and entered via DTMF by a user.).

Claims 13 and 33: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of recognizing said speech annotations of said caller (page 4, lines 27-29, 'Message generator 23 records voice from the user, composes it as an E-mail message [i.e. recognizes and performs speech-to-text operation]. ').

Claims 14 and 34: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of converting said speech annotations to text (page 4, lines 27-29, 'composes it as an E-mail message,').

Claims 15 and 35: **Pizano** discloses a method and apparatus as per claims 14 and 34 above wherein said step of converting annotated voice command to text is accomplished using

Automatic Speech Recognition (ASR) and Speech-to-Text conversion (page 4, lines 27-29, 'composes it as an E-mail message,').

Claims 17 and 37: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, wherein said speech annotation is inserted in said original message as a sound file (page 5, lines 5-11).

Claims 18 and 38: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of storing said annotated message at the Unified Messaging server after inserting said speech annotation into said message (page 4, lines 28-31).

Claims 20 and 40: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, further comprising the step of forwarding said annotated message to another user (page 4, line 29, '*which delivers it as a voice message to the originator.*').

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9, 12, 29, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pizano** in view of **Kurganov (US 2001/0054085 A1)** referred to as **Kurganov** hereinafter.

Claims 9, 12, 29 and 32: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, however, wherein **Pizano** does distinctly disclose a user having the capability to interact with a system using predetermined commands, **Pizano** fails to distinctly disclose wherein said

commands are user-defined speech commands. However, **Kurganov** does disclose a personal voice-based system for gathering information by use of commands, specifically disclosing the use of user assigned speech commands for interacting with and causing an automated system to perform desired tasks (Abstract, 'This record identifies the location of the information source and also contains a recognition grammar based upon a speech command assigned by the user. Upon receiving the speech command from the user...').

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to include the teachings of **Kurganov** in the system of **Pizano** because speech recognition allows a user to perform said tasks simply by the use of a telephone as well as provide a level of customization suited to each user (**Kurganov**, col. 1, paragraphs [0004]-[0007]).

8. Claims 16 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pizano** in view of **Handley** (USPN 5,349,648) referred to as **Handley** hereinafter.

Claims 16 and 36: **Pizano** discloses a method and apparatus as per claims 1 and 21 above, however failing to, but **Handley** does, disclose the automatic insertion of text when correcting or annotating a document (e.g. E-mail) (col. 16, lines 29-34).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of invention to include the teachings of **Handley** in the system of **Pizano** because this would save a substantial amount of time and energy, especially when dealing with numerous messages (**Handley**, col. 16, lines 25-30).

9. Claims 19 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pizano**.

Claims 19 and 39: **Pizano** discloses a method and apparatus as per claims 18 and 38 above, however failing to distinctly disclose wherein a new copy of an annotated message is created with inserted annotations (It appears as though the newly added language appears to merely re-iterate what was already being claimed [i.e. 'storing said annotated message']). **Pizano** does disclose wherein an annotated message (which would inherently include the message along with any annotations.) is saved for use at a later time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to create another copy since it was known to one possessing ordinary skill in the art that if the capability to save a document or message is present, it is common knowledge within the computing arts that it is also possible to recreate said document a multitude of times. One of the key advantageous features of digital storage is the constant reproducibility of results useful in 'backing up' important documents. This allows for the storage of a master copy on a server in the event that an important annotated message becomes lost or corrupted, while still providing other copies to be distributed to the people that the message was originally intended for.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin W. Rider whose telephone number is (571) 270-1068. The examiner can normally be reached on Monday - Friday 7:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

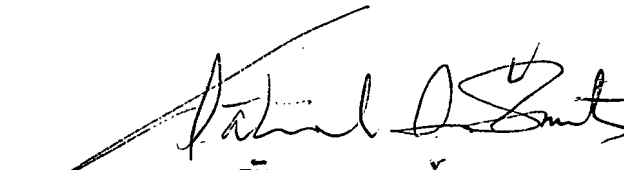
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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J.W.R.
14 November 2007



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PRIMARY EXAMINER